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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,493	04/09/2004	Donald Edward Williams SR.	OSU 0018 PA/41096.37	1428

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EXAMINER	
MEISLIN, DEBRA S	
ART UNIT	PAPER NUMBER
3723	

DATE MAILED: 01/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/821,493	WILLIAMS, DONALD EDWARD	
	Examiner	Art Unit	
	Debra S. Meislin	3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 November 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5-8,10-14,17-25 and 35-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *5,10-14,17-25 and 35-39* is/are rejected.

7)☒ Claim(s) *6-8* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Claims 35-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 35, line 9, "said pawls" lacks antecedent basis.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 12-14, 25, 35, and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Figure 1 of the instant invention in view of Hermanson, and in the alternative, Hermanson in view of Figure 1 of the instant invention.

Figure 1 of the instant invention discloses all of the claimed subject matter except for having a ratcheting member wherein the pawls make up a portion of a race and a hinge. Hermanson discloses a wrench having a handle, a nut engaging member, a ratcheting member wherein the pawls make up a portion of a race, a hinge, and a rotatable workpiece have outer engaging portions for rotation thereof. It would have been obvious to one having ordinary skill in the art to form the device of Figure 1 of the instant invention with a ratcheting mechanism wherein the pawls make up a portion of a race to allow for quick rotation of the workpiece as taught by Hermanson. It would have been obvious to one having ordinary skill in the art to form the device of Figure 1 of the instant invention with a hinge to allow for selected orientation of the tool head as taught by Hermanson.

Hermanson et al discloses all of the claimed subject matter except for having for having a nut disposable on a shock absorber. Hermanson discloses a wrench having a handle, a nut engaging member, a ratcheting member wherein the pawls make up a portion of a race and a rotatable workpiece have outer engaging portions for rotation thereof. Figure 1 of the instant invention discloses a nut disposable on a shock absorber. It would have been obvious to one having ordinary skill in the art to use the device of Hermanson on a nut disposable on a shock absorber to enable rotation thereof as taught by Figure 1 of the instant invention.

With respect to claim 37, the examiner takes Official Notice that the use of thrust bearings is notoriously old and well known in the art for engagement with a nut to hold the nut in place. It would have been obvious to one having ordinary skill in the art to provide the device of Hermanson et al or of Figure 1 of the instant invention with at least one thrust bearing as such is notoriously old and well known in the art for engagement with a nut to hold the nut in place.

4. Claims 17 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Figure 1 of the instant invention in view of Hermanson, and in the alternative, Hermanson in view of Figure 1 of the instant invention as applied above, in further view of Reaves.

Reaves discloses an adapter ring having a plurality of teeth on the periphery thereof configured to engage a pawl. It would have been obvious to one having ordinary skill in the art to form the device of Figure 1 of the instant invention in view of Hermanson, or in the alternative, Hermanson in view of Figure 1 of the instant invention

with an adapter ring having a plurality of teeth on the periphery thereof configured to engage a pawl to enable engagement of a workpiece having the shape of the interior surface of the adapter ring for rotation of the workpiece as taught by Reaves.

5. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Figure 1 of the instant invention in view of Hermanson, and in the alternative, Hermanson in view of Figure 1 of the instant invention in view of Reaves as applied above, in further view of Ozaki et al.

Ozaki et al discloses a nut having a bore, a securing member, and a block. It would have been obvious to one having ordinary skill in the art to form the nut of the device of Figure 1 of the instant invention or of Hermanson in view of Figure 1 of the instant invention with a bore, a securing member, and a block to lock the nut in place as taught by Ozaki et al.

6. Claims 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Figure 1 of the instant invention in view of Hermanson, and in the alternative, Hermanson in view of Figure 1 of the instant invention, as applied above.

The examiner takes Official Notice that forming nuts with various materials such as those lower in density than steel, lightweight metal, aluminum, aluminum alloys, anodized aluminum, anodized aluminum alloys, or a protective layer are all old and well known in the nut art as such is dependent upon the use of the nut. Consequently, it would have been obvious to one having ordinary skill in the art to form the nut of Figure 1 of the instant invention or of Hermanson out of any of a variety of materials as such is old and well known in the art.

7. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Figure 1 of the instant invention in view of Hermanson, and in the alternative, Hermanson in view of Figure 1 of the instant invention as applied above, in further view of Mitchell or Taggart.

Mitchell discloses ratcheting angles of rotation of 4, 6, and 8 degrees. Taggart discloses a ratcheting angle of rotation of approximately 7 degrees. It would have been obvious to one having ordinary skill in the art to form the device of Hermanson with a ratcheting angle of rotation up to six degrees or approximately four degrees to minimize the swing angle for work in confined spaces as taught by Mitchell or Taggart.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Figure 1 of the instant invention in view of Hermanson, and in the alternative, Hermanson in view of Figure 1 of the instant invention as applied above, in view of Reaves and in further view of Furey (4562757).

Furey discloses an adapter ring comprising a plurality of complementary parts. It would have been obvious to one having ordinary skill in the art to form the adapter ring of Reaves out of a plurality of complementary parts to enable the full engagement of a workpiece as taught by Furey.

9. Claims 6-8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Applicant's arguments filed November 7, 2005 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant has failed to address the rejections based upon the teachings of Figure 1 of the instant invention. Figure 1 of the instant invention discloses the claimed subject matter as alleged missing by applicant's arguments.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, there is some

teaching; suggestion, or motivation to do so found in the references themselves as set forth, above.

Ozaki et al was applied to the rejection of the claims to teach only the concept of forming the nut of the device of Figure 1 of the instant invention or of Hermanson in view of Figure 1 of the instant invention with a bore, a securing member, and a block to lock the nut in place as taught by Ozaki et al. Ozaki et al was not applied to the rejection of the claims to teach what was already taught by the primary reference.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra S. Meislin whose telephone number is 571 272-4487. The examiner can normally be reached on M-F, alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571 272 4485. The fax phone number for the organization where this application or proceeding is assigned is 571 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Debra S Meislin
Primary Examiner
Art Unit 3723

January 10, 2006